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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/072,206	06/04/93	SCHWARTZ R	INTT3POUS

EXAMINER	
MANCUSO, J	
ART UNIT	**PAPER NUMBER**
2613	12

E6M1/1002

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DATE MAILED: 10/02/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 7/18/95 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire three month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____.

Part II SUMMARY OF ACTION

1. ☒ Claims 1-11 are pending in the application.
   Of the above, claims 6,7,11 are withdrawn from consideration.
2. ☒ Claims 12 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-5, 8-10 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____ ; filed on _____.
13. ☐ Since this application apppears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

1. Applicant's election without traverse of claims 1-5, 8-10 in Paper No. 11 is acknowledged.

2. Applicant's arguments filed January 18, 1995, have been fully considered but they are not deemed to be persuasive.

3. Claims 1-5 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 7-8 recite analyzing the position of the probes, but the actual recitation of determining the position is not recited until later in the claim (lines 9-12). This is unclear, as the position can not be analyzed until the position is first determined. If the claim recitation is intended to be that the computer means includes the positioning means and the automated means, then the claim should be amended to so recite.

4. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same

person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

Claims 1, 2, 4, and 9 are rejected under 35 U.S.C. § 103 as being unpatentable over Sato et al. in view of Stewart et al. ('374).

The statements advanced in paragraph 6, of paper number 5, as to the applicability and disclosure of Sato et al. are incorporated herein.

With respect to amended claim 1, as well as amended claim 9, Sato discloses a system for a probe device, comprising: a viewing system for providing an image of each probe (20 in Fig. 5, for example); a window (21), with a flat surface, for viewing each probe thru; and a computer means for determining the position of the probes and for evaluating the determined positions. However, the reference does not appear to specifically recite that the images are "digital" or the evaluation of a "probe card" as currently recited in the claims. However, as to the first point, it is very conventional to use digital images for processing, particularly when using digital means (such as the computer) for processing the images. Therefore, to one of ordinary skill in the

art, it would have been obvious, at the time of the invention, to use a digital camera (or an A/D) to provide the necessary digital data for processing by the computer. As to the second point, Stewart is directed a system wherein probe cards are inspected by an automated system (see Abstract, for example). To one of ordinary skill in the art, it would have been obvious, at the time of the invention, to use the system of Sato to inspect the probe cards as discussed by Stewart because of the conventionality of the inspection of these items and because both systems are for the inspection of similar devices.

5. Claims 3, 5, 8, and 10 are rejected under 35 U.S.C. § 103 as being unpatentable over as applied to claim above, and further in view of Chang et al.

The statements advanced in paragraph 7, of paper number 5, as to the applicability and disclosure of the references are incorporated herein.

6. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL.** See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE

ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Mancuso whose telephone number is (703) 305-4927.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-8576.

The Art Unit 2613 Fax number is (703)-308-6606.

jm
October 1, 1995